

ESTTA Tracking number: **ESTTA779297**

Filing date: **10/26/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	BlackBerry Limited
Granted to Date of previous extension	10/26/2016
Address	2200 University Avenue East Waterloo, N2K 0A7 CANADA

Attorney information	G. Roxanne Elings Davis Wright Tremaine LLP 1251 Avenue of the Americas 21st Floor New York, NY 10020 UNITED STATES blackberry@dwt.com, blackberryrecords@dwt.com, roxanneelings@dwt.com, lisakeith@dwt.com, danielletaltoan@dwt.com, orrinfalby@dwt.com m Phone: 212 489 8340
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### Applicant Information

Application No	86734866	Publication date	06/28/2016
Opposition Filing Date	10/26/2016	Opposition Period Ends	10/26/2016
Applicant	LG ELECTRONICS INC. 128, Yeoui-daero, Yeongdeungpo-gu Seoul 150-721, KOREA, REPUBLIC OF		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Smart phones; portable communications apparatus namely, handsets, walkie-talkies, satellite telephones and personal digital assistants; Audio electronic components system, comprising surround sound speakers, loud speakers, tuners, sound mixers, equalizers, audio recorders, and radios; Apparatus for the recording, transmission and reproduction of sound and images; Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of message in the nature of data, text, language, sound, image and video; Television receivers; Wearable smart phones; Mobile phone cases; Mobile phone stands; Computer stylus for smart phones; Portable chargers for mobile phones; Headphones; Ear phones; Wireless headphones

### Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)


No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3102687	Application Date	09/03/2004
Registration Date	06/13/2006	Foreign Priority Date	NONE
Word Mark	BLACKBERRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/06/23 First Use In Commerce: 2004/06/23 Electronic handheld units and accessories therefore, namely, batteries, cases, battery chargers, holsters and antennas, for the wireless receipt and/or transmission of data and which may also have the capability to transmit and receive voice communications, namely handheld computers and personal digital assistants; computer communications software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; computer communication software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, including corporate data</p> <p>Class 038. First use: First Use: 2004/06/23 First Use In Commerce: 2004/06/23 e-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services</p> <p>Class 041. First use: First Use: 2004/06/23 First Use In Commerce: 2004/06/23 consulting and educational services namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, including corporate data, and/or voice communications</p>		

U.S. Registration No.	3715717	Application Date	03/27/2007
Registration Date	11/24/2009	Foreign Priority Date	NONE
Word Mark	BLACKBERRY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2007/12/31 First Use In Commerce: 2009/03/02 retail store services in the field of telecommunication equipment

U.S. Registration No.	2844340	Application Date	11/26/2002
Registration Date	05/25/2004	Foreign Priority Date	NONE
Word Mark	BLACKBERRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1998/07/14 First Use In Commerce: 1999/01/19 Electronic handheld units for the wireless receipt and/or transmission of data that enable the user to keep track of or manage personal information and which may also have the capacity to transmit and receive voice communications; software for the redirection of messages, global computer network e-mail, and other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and two-way wireless connectivity to data, including corporate data</p> <p>Class 038. First use: First Use: 1998/07/14 First Use In Commerce: 1999/01/19 E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services; consultation on the topics of developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and/or communications</p> <p>Class 041. First use: First Use: 1998/07/14 First Use In Commerce: 1999/01/19 Educational services, namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and voice communications</p>		

U.S. Registration No.	3715716	Application Date	03/27/2007
Registration Date	11/24/2009	Foreign Priority Date	NONE

Word Mark	BLACKBERRY
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2007/12/31 First Use In Commerce: 2009/03/02 retail store services in the field of telecommunication equipment

U.S. Registration No.	2700671	Application Date	12/28/1998
Registration Date	03/25/2003	Foreign Priority Date	NONE
Word Mark	BLACKBERRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1998/07/14 First Use In Commerce: 1999/01/19 E-mail service; wireless data messagingservices, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services		

U.S. Registration No.	2672464	Application Date	12/28/1998
Registration Date	01/07/2003	Foreign Priority Date	NONE
Word Mark	BLACKBERRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/07/14 First Use In Commerce: 1999/01/19 Electronic handheld units for the wireless receipt and/or transmission of data,that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; andsoftware for the synchronization of data between a remote station or unit and a fixed or remote station or unit		

U.S. Registration No.	3098588	Application Date	03/02/2004
Registration Date	05/30/2006	Foreign Priority Date	NONE
Word Mark	BLACKBERRY CONNECTION		

Design Mark	<b>BLACKBERRY CONNECTION</b>
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 Newsletter relating to internet e-mail services and wireless data messaging services and voice communication services and technical support services for hardware and software for wireless data network services and voice communication services

U.S. Registration No.	3836417	Application Date	09/03/2004
Registration Date	08/24/2010	Foreign Priority Date	NONE


Word Mark	BLACKBERRY
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Design Mark	
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Description of Mark	The mark consists of a shaded quadrilateral with the wording BLACKBERRY below astylized geometric design of the letters BBBB.
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Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Electronic handheld units and accessories therefor, namely, batteries, chargers, headsets, cases, covers, and docking stations, for the wireless receipt and transmission of data and which may also have the capability to transmit and receive voice communications, namely, handheldcomputers and personal digital assistants; computer communications software forthe transmission and reception of messages, global computer network e-mail and other data between one or more electronic handheld units and a data store on or associated with a personal computer or aserver; computer communication softwarefor the synchroniz-ation of data betweena remote station or unit and a fixed orremote station or unit and software which enables and provides one-way and two-way wireless connectivity to data, namely, corporate data
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	<p>Class 038. First use: First Use: 0 First Use In Commerce: 0 e-mail service; wireless data messaging services, particularly services that enable a user to send and receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communications services</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Conducting educational classes, seminars workshops and on line training classes in the nature of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, including corporate data, voice communications</p>
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U.S. Registration No.	4400318	Application Date	09/26/2007
Registration Date	09/10/2013	Foreign Priority Date	NONE
Word Mark	BLACKBERRY CURVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 2007/05/01 First Use In Commerce: 2007/05/18 Bags, namely, backpacks, sport bags, duffle bags, casual bags, namely, casual all-purpose carrying bags, casual bags in the nature of purses, unique leather cases in the nature of carrying cases and key cases, luggage and carry-all bags, beach bags, handbags, clutch bags, shoulder bags, wallets, purses, briefcases, briefcase type portfolio cases, attaché cases, key cases, bill folds, coin purses, bum bags, wallets with compartments for passports, travel bags, haversacks, luggage, trunks; umbrellas; luggage bag tags</p>		


U.S. Registration No.	4615742	Application Date	11/09/2010
Registration Date	10/07/2014	Foreign Priority Date	05/14/2010
Word Mark	BLACKBERRY TRAFFIC		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 wireless handheld devices, namely, personal digital assistants, wireless phones, mobile phones, cellular phones, smartphones and video phones; computer software to enable the transmission of mapping, navigation, traffic, weather and point-of-interest information to telecommunications networks; wireless handheld devices, namely, electronic handheld units in the nature of mobile, slate, and tablet computers, and navigation devices; computer software to be used for viewing and downloading electronic maps; computer software for operating route planners</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunication carrier services, namely, providing access to third-party electronic databases by means of one-way or two-way wireless connectivity, including corporate and home/personal data, and providing access to GPS (Global Positioning System) navigation services</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0 Providing GPS (Global Positioning System) navigation services; providing navigation, traffic and point-of-interest navigation information via telecommunication networks, mobile phones, telephones, smartphones, electronic handheld units and navigation devices</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 providing mapping and point-of-interest mapping information via telecommunication networks, mobile phones, telephones, smartphones, electronic handheld units and navigation devices; software as a service (SAAS) services, namely, hosting third-party software and applications for personal digital assistants (PDAs), wireless phones, mobile phones, cellular phones, smart phones, mobile computers and tablet computers, all for use by others; providing search engines for obtaining data via communications networks</p>

U.S. Registration No.	4403721	Application Date	03/24/2011
Registration Date	09/17/2013	Foreign Priority Date	NONE
Word Mark	BLACKBERRY WEBWORKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2011/04/00 First Use In Commerce: 2011/04/00 Computer software development tools for developing software for web-based applications</p>		


U.S. Registration No.	4532194	Application Date	05/08/2013
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Registration Date	05/20/2014	Foreign Priority Date	NONE
Word Mark	BLACKBERRY WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2013/02/20 First Use In Commerce: 2013/02/20 Computer software for accessing, displaying, browsing, transmitting and downloading software, mobile application software, computer game software, music, and multimedia, audio, and video files; downloadable computer software for accessing, displaying, browsing, transmitting and downloading software, mobile application software, computer game software, music, and multimedia, audio, and video files</p> <p>Class 035. First use: First Use: 2013/02/20 First Use In Commerce: 2013/02/20 Retail store services featuring computer software, downloadable software, mobile application software, downloadable computer game software, downloadable music, and downloadable multimedia, audio, and video files; and online retail store services featuring computer software, downloadable software, mobile application software, downloadable computer game software, downloadable music, and downloadable multimedia, audio, and video files</p>		

U.S. Registration No.	4732984	Application Date	03/28/2014
Registration Date	05/05/2015	Foreign Priority Date	NONE
Word Mark	BLACKBERRY CLASSIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2014/12/00 First Use In Commerce: 2014/12/00 Mobile phones; smartphones		

U.S. Registration No.	4676913	Application Date	09/04/2008
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Registration Date	01/27/2015	Foreign Priority Date	03/06/2008
Word Mark	BLACKBERRY BOLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>Apparatus for recording, transmission or reproduction of data, sound or images, namely, electronic handheld units, mobile phones, telephones, smartphones, personal digital assistants (PDAs) for the wireless transmission of data and/or voice signals; electronic handheld units, mobile phones, telephones, smartphones, personal digital assistants (PDAs), with capabilities of e-mail, pager, fax, radio, personal organizer, cellular connectivity, wireless Internet connectivity, mp3player, satellite navigational system, GPS (Global Positioning System) receiver, global positioning system data logger for recording and classification of trips, digital camera, digital video camera and/or computer operating system; electronic handheld units for recording, organizing, transmitting, playing and reviewing text, data, video and audio files, and accessories for electronic handheld units, telephones, mobile phones, smartphones, and personal digital assistants (PDAs) for the wireless transmission of data and/or voice signals, namely, batteries, battery chargers, speakers, headsets, microphones, belt clips, speciality holsters, carrying cases, battery covers, battery doors, charging pods, docking/charging cradles, holders, desktop stands, data cables, electric adapter cables and electrical wires; car kits for the adaptation of portable communication apparatus and instruments for use in vehicles, comprising antennas, antenna transmission wires, antenna adapters, cables, car phones, handsfree microphones, phone holders, speakers, car chargers for mobile telephone batteries, handsfree holders; computer software, namely, software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server, software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one way and/or two-way wireless connectivity to data, namely, corporate data; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data stored on or associated with a computer</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0</p> <p>Telecommunication services, namely, the synchronization, transmission and sharing of voice, sound, image and/or data signals through a wireless data network; providing access to the Internet; providing access to electronic databases; providing access to global positioning system (GPS) navigation services; providing e-mail services; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services via the internet and other computer and electronic communication networks and wireless devices; telecommunications consulta-</p>		

	<p>tion, namely, providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, namely, corporate and home/personal data, and/or voice communications</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Consultancy and technical support services, namely, diagnosing computer hardware and software problems for telecommunication and Global Positioning System (GPS) services; technical support services, namely, updating and maintenance of computer software and troubleshooting support programs for diagnosis and resolution of wireless connectivity devices and related computer software and hardware problems</p>
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Attachments	<p>76610159#TMSN.png( bytes )</p> <p>77141641#TMSN.png( bytes )</p> <p>76469782#TMSN.png( bytes )</p> <p>77141621#TMSN.png( bytes )</p> <p>76578564#TMSN.png( bytes )</p> <p>76610160#TMSN.png( bytes )</p> <p>77289919#TMSN.png( bytes )</p> <p>85172152#TMSN.png( bytes )</p> <p>85275562#TMSN.png( bytes )</p> <p>85926329#TMSN.png( bytes )</p> <p>86235056#TMSN.png( bytes )</p> <p>77562872#TMSN.png( bytes )</p> <p>2016 10 26 Classic Black - Notice of Opposition.pdf(89182 bytes )</p>
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/GRE/
Name	G. Roxanne Elings
Date	10/26/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 86/734,866  
Mark: CLASSIC BLACK  
Published in the *Official Gazette* on June 28, 2016

BlackBerry Limited,

Opposer,

v.

LG Electronics, Inc.,

Applicant.

Opposition No.:

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

BlackBerry Limited (hereinafter referred to as “BlackBerry” or “Opposer”) believes that it will be damaged by registration of the above-identified trademark and hereby opposes the registration thereof:

**FACTS**

**Applicant’s Mark**

1. Upon information and belief, LG Electronics, Inc. (“Applicant” or “LG”) is a corporation organized and existing under the laws of the Republic of Korea, having a place of business located at 128, Yeoui-daero, Yeongdeungpo-gu, Seoul 150-721.

2. On or about August 24, 2015, Applicant filed Trademark Application Serial No. 86/734,866, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), to register the

composite CLASSIC BLACK (“Applicant’s Mark”), as a trademark on the Principal Register for use on or in connection with the following goods in International Class 9: “Smart phones; portable communications apparatus namely, handsets, walkie-talkies, satellite telephones and personal digital assistants (PDA); Audio components; Apparatus for the recording/transmission or reproduction of sound and images; Computer application software; Computer application software for mobile phones; Television receivers; Wearable smart phones; Mobile phone cases; Mobile phone stands; Stylus for smart phones; Portable chargers for mobile phones; Headphones; Ear phones; Wireless headphones” (the “Application”).

3. On or about December 7, 2015, an Office Action was issued on the grounds that certain descriptions of goods identified in the Application were indefinite and that the term BLACK in Applicant’s Mark merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of Applicant’s goods, and thus is an unregistrable component of the mark, pursuant to Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1), and as a result, must be disclaimed, pursuant to Section 6(a) of the Lanham Act, 15 USC §1056(a).

4. On or about May 24, 2016, Applicant filed a response to the December 7, 2015 Office Action disclaiming the exclusive rights to the term BLACK and amending the description of the goods recited in the Application to state the following:

Class 9: Smart phones; portable communications apparatus namely, handsets, walkie-talkies, satellite telephones and personal digital assistants; Audio electronic components system, comprising surround sound speakers, loud speakers, tuners, sound mixers, equalizers, audio recorders, and radios; Apparatus for the recording, transmission and reproduction of sound and images; Computer application software for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications; Computer application software for mobile phones for receiving and transmission of message in the nature of data, text, language, sound, image and video; Television receivers; Wearable smart phones; Mobile phone cases; Mobile phone stands; Computer stylus for smart phones; Portable chargers for mobile phones; Headphones; Ear phones; Wireless headphones

(“Applicant’s Goods”).

5. On or about June 28, 2016, Applicant’s Mark was published for opposition in the *Official Trademark Gazette*.

6. Prior to the publication of Applicant’s Mark on June 28, 2016, a Letter of Protest was submitted by a third party to the Office of the Deputy Commissioner on the grounds that the Examining Attorney did not consider evidence demonstrating that Applicant’s Mark is commonly used as a color in connection with at least some of Applicant’s Goods and is therefore merely descriptive under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

7. On or about July 6, 2016, the Letter of Protest was accepted by the Office of the Deputy Commissioner and jurisdiction was restored to the Examining Attorney.

8. On or about July 27, 2016, Opposer timely filed a ninety-day Request for an Extension of Time in which to file a Notice of Opposition, which was simultaneously approved, extending the deadline to oppose the Application to October 26, 2016.

9. On or about September 1, 2016, the Examining Attorney issued an Office Action refusing the Application on the grounds that Applicant’s Mark merely describes a feature, characteristic, function, feature, purpose, or use of Applicant’s Goods, pursuant to Section 2(e)(1) of the Lanham Act, 15 USC § 1052 (e)(1).

10. Applicant has not yet responded to the September 1, 2016 Office Action and Applicant’s time to do so will expire on or about March 1, 2017.

#### **Opposer’s Marks and Business**

11. BlackBerry, including its predecessors-in-interest, is a global leader in the research, development, design, manufacture, promotion and marketing of innovative mobile communications technology solutions. In 1999, BlackBerry revolutionized the mobile

communications industry when it launched its first mobile handheld communications device. By the year 2005, BLACKBERRY mobile devices had become ubiquitous throughout the world and an important tool for business executives, government officials, and many other professionals as a means for round-the-clock mobile communications.

12. Since at least as early as 1999, BlackBerry has used its BLACKBERRY house mark and other related trademarks, including the trademark BLACKBERRY CLASSIC (collectively, the “BLACKBERRY Marks”), to identify its mobile handheld communication devices (mobile phones, smartphones, PDAs, computer tablets), mobile applications, accessories, computer software, systems software applications, and mobile device management services (collectively “BlackBerry’s Goods/Services”).

13. Specifically, BlackBerry has used the trademark BLACKBERRY CLASSIC since at least as early as 2014 in connection with mobile phones and smartphones. The BLACKBERRY CLASSIC is a touchscreen-based smartphone with a physical keyboard that was launched in 2014 to positive reviews from critics and customer acclaim and contains all of the traditional design features for which BlackBerry has become renowned.

14. The BLACKBERRY CLASSIC smartphone is widely recognized by the telecommunications industry and the consuming public and has come to represent and symbolize the extremely valuable goodwill and widespread reputation belonging exclusively to BlackBerry.

15. The BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, are the subject of numerous valid and subsisting United States trademark registrations on the Principal Register, some of which are incontestable, pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, including but not limited to the marks depicted in the chart attached hereto as Exhibit A.

16. BlackBerry markets and sells its goods and services, including accessories and services bearing the BLACKBERRY Marks in the United States and throughout the world through all of the major wireless telecommunications service providers, including AT&T, Verizon, Sprint, and T-Mobile and through electronic and computer stores and outlets such as Best Buy, Costco, Amazon, Walmart, and Target -- just to name a few. BlackBerry also operates websites located at the following URLs: <shopblackberry.com> and <us.blackberry.com>, through which it markets and sells its mobile handheld devices and accessories and distributes and promotes its software applications and services.

17. BlackBerry's Goods/Services are used by some of the world's largest and most successful organizations, companies, and governmental institutions. Blackberry has also partnered with premier sports leagues and media outlets such as the MLB, the NHL, PGA Tour, ESPN, UFC, and CBS Sports to build applications for BlackBerry platforms.

18. BlackBerry has invested significant time, energy, and resources in the advertising, promotion, and distribution of its BlackBerry Goods/Services in media advertising, including television ads, the Internet, printed trade publications, magazines of general circulation, and point-of-sale displays. Additionally, BlackBerry has been the official sponsor of the Mercedes AMG Formula One Racing Team, Barclays Center and the Brooklyn Nets, the Toronto International Film Festival, the 2011 Rugby World Cup, and has sponsored the tours of various well-known musical artists, including Alicia Keys, U2, and the Black Eyed Peas.

19. The success of BlackBerry's marketing and promotional efforts have not gone unnoticed, and BlackBerry has benefited from the publicity garnered from unsolicited media coverage of its goods and services. For example, it is widely known that the President of the United States, Barack Obama, has used a BLACKBERRY device during most of his presidency.

Multiple media outlets have often referred to President Obama as the “BlackBerry president.” Additionally, celebrities, including Justin Timberlake, Martha Stewart, Paris Hilton, will.i.am, Lindsay Lohan, Kanye West, Jay-Z, Katy Perry, Drake, Nick Cannon, Sarah Jessica Parker, Puff Daddy, Christina Aguilera, and Kim Kardashian – just to name a few, have all been photographed with or been reported to use BLACKBERRY devices.

20. As a result of BlackBerry’s marketing efforts and success, combined with its attention to quality, design, and performance of its products, the goods and services sold under the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, have generated hundreds of millions of dollars in sales each year.

21. By virtue of the extensive distribution and success of BlackBerry’s Goods/Services, the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, are recognized and relied upon by the public and trade as identifying BlackBerry’s Goods/Services and distinguishing them from the goods and services of others. Further, the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark have come to represent and symbolize the extremely valuable goodwill and widespread reputation belonging exclusively to BlackBerry.

22. By virtue of the extensive distribution and success of the BLACKBERRY branded goods and related services, Opposer’s BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, are distinctive and famous.

### **COUNT I**

### **MERELY DESCRIPTIVE MARK**

23. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 22 herein.



24. Applicant's Mark consists of two highly descriptive terms that are commonly used by manufacturers of some of the goods identified in the Application and many of Opposer's registrations for the BLACKBERRY Marks, including, without limitation, its registration for the BLACKBERRY CLASSIC trademark.

25. The term CLASSIC is defined as "serving as a standard or model of its kind; definitive".

26. The term BLACK is defined as "of the very darkest color owing to the absence of or complete absorption of light; the opposite of white".

27. Each of the constituent elements of the composite, CLASSIC BLACK, is itself descriptive of Applicant's Goods.

28. Upon information and belief, the combination of the components to form the composite, CLASSIC BLACK, does not create a distinct commercial impression that is independent of constituent elements when used in connection with Applicant's Goods.

29. Upon information and belief, the composite, CLASSIC BLACK, is commonly used to describe a color by manufacturers of the goods identified in the Application and many of Opposer's registrations for the BLACKBERRY Marks, including, without limitation to, its registration for the BLACKBERRY CLASSIC trademark.

30. The phrase "classic black" will be immediately understood by consumers to describe a color, feature, quality and/or characteristic of Applicant's Goods.

31. Therefore, Applicant's Mark used in connection with Applicant's Goods is in violation of Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

**COUNT II**  
**LIKELIHOOD OF CONFUSION**

32. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 31 herein.

33. The BLACKBERRY Marks are famous in the United States and throughout the world.

34. Opposer commenced use of the BLACKBERRY Marks well before Applicant filed the Application and/or commenced use of Applicant's Mark in commerce.

35. Applicant's Mark is similar to the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, in sight, sound, connotation, and overall commercial impression.

36. The goods identified in the Application are identical, complementary, similar and/or related to the goods with which Opposer is using the BLACKBERRY Marks.

37. The goods identified in the Application are identical, complementary, similar, and/or related to the goods for which the BLACKBERRY Marks are registered.

38. Registration of Applicant's Mark is likely to cause confusion, mistake, or deception as to the source of Applicant's Goods in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

### **COUNT III** **DILUTION**

39. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 38 herein.

40. Through Opposer's extensive advertisement and promotion and substantial sales, the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, have become famous in the United States and throughout the world.

41. Any use by Applicant of Applicant's Mark has occurred after the BLACKBERRY Marks became famous.

42. Relevant consumers are likely to make an association between Applicant's Mark and Opposer's BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark.

43. Applicant's Mark is likely to impair the distinctiveness of Opposer's BLACKBERRY Marks.

44. Applicant's Mark is likely to blur and/or tarnish the positive associations with Opposer's BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark.

45. Thus, Applicant's registration and/or use of Applicant's Mark is likely to cause dilution of the distinctive quality of Opposer's BLACKBERRY Marks in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(c).

**COUNT IV**  
**FALSE SUGGESTION OF CONNECTION**

46. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 45 herein.

47. Opposer's BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark are famous in the United States and throughout the world.

48. Applicant's Mark creates the same or similar commercial impression as, or is a close approximation of, the BLACKBERRY Marks, including, but not limited to the BLACKBERRY CLASSIC mark, and falsely suggests a connection with BlackBerry.

49. BlackBerry is not connected in any way with the goods of Applicant.

50. Due to the fame of Opposer and the BLACKBERRY Marks, when Applicant's Mark is used in commerce, a connection with Opposer is presumed by the consuming public.

51. Thus, Applicant's registration and/or use of Applicant's Mark is likely to create a false sense of connection to Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

**COUNT V**  
**LACK OF BONA FIDE INTENT**

52. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 51 herein.

53. Upon information and belief, Applicant did not have a bona fide intent to use Applicant's Mark in connection with each of the goods identified in the Application on the date that Applicant filed the Application.



WHEREFORE, Opposer prays that this Opposition be sustained and that Application Serial No. 86/734,866 be rejected, and that registration of the designation therein sought be denied and refused.

Dated: New York, NY  
October 26, 2016


Respectfully submitted,  
DAVIS WRIGHT TREMAINE LLP

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# EXHIBIT A

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
	3102687	June 13, 2006	<p><b>Class 9:</b> Electronic handheld units and accessories therefore, namely, batteries, cases, battery chargers, holsters and antennas, for the wireless receipt and/or transmission of data and which may also have the capability to transmit and receive voice communications, namely handheld computers and personal digital assistants; computer communications software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; computer communication software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, including corporate data.</p> <p><b>Class 38:</b> e-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services.</p> <p><b>Class 41:</b> consulting and educational services namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, including corporate data, and/or voice communications.</p>
	3715717	November 24, 2009	<p><b>Class 35:</b> retail store services in the field of telecommunication equipment.</p>
BLACKBERRY	2844340	May 25, 2004	<p><b>Class 9:</b> Electronic handheld units for the wireless receipt and/or transmission of data that enable the user to keep track of or manage personal information and which may also have the capacity to transmit and receive voice communications; software for the redirection of messages, global computer network e-mail, and other data to one or more electronic</p>

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			<p>handheld units from a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and two-way wireless connectivity to data, including corporate data.</p> <p><b>Class 38:</b> E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services; consultation on the topics of developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and/or communications.</p> <p><b>Class 41:</b> Educational services, namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and voice communications.</p>
BLACKBERRY	3715716	November 24, 2009	<b>Class 35:</b> retail store services in the field of telecommunication equipment.
BLACKBERRY	2700671	March 25, 2003	<b>Class 38:</b> E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services.
BLACKBERRY	2672464	January 7, 2003	<b>Class 9:</b> Electronic handheld units for the wireless receipt and/or transmission of data, that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or unit and a fixed or remote station or unit.

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
BLACKBERRY CONNECTION	3098588	May 30, 2006	<b>Class 16:</b> Newsletter relating to internet e-mail services and wireless data messaging services and voice communication services and technical support services for hardware and software for wireless data network services and voice communication services.
	3836417	August 24, 2010	<p><b>Class 9:</b> Electronic handheld units and accessories therefor, namely, batteries, chargers, headsets, cases, covers, and docking stations, for the wireless receipt and transmission of data and which may also have the capability to transmit and receive voice communications, namely, handheld computers and personal digital assistants; computer communications software for the transmission and reception of messages, global computer network e-mail and other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; computer communication software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and two-way wireless connectivity to data, namely, corporate data</p> <p><b>Class 38:</b> e-mail service; wireless data messaging services, particularly services that enable a user to send and receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services</p> <p><b>Class 41:</b> Conducting educational classes, seminars workshops and on line training classes in the nature of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, including corporate data, voice communications</p>
BLACKBERRY CURVE	4400318	September 10, 2013	<b>Class 18:</b> Bags, namely, backpacks, sport bags, duffle bags, casual bags, namely, casual all-purpose carrying bags, casual bags in the nature of purses, unique leather cases in the nature of carrying cases and key cases,

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			luggage and carry-all bags, beach bags, handbags, clutch bags, shoulder bags, wallets, purses, briefcases, briefcase type portfolio cases, attaché cases, key cases, bill folds, coin purses, bum bags, wallets with compartments for passports, travel bags, haversacks, luggage, trunks; umbrellas; luggage bag tags
BLACKBERRY TRAFFIC	4615742	October 7, 2014	<p><b><u>Class 9:</u></b> Wireless handheld devices, namely, personal digital assistants, wireless phones, mobile phones, cellular phones, smartphones and video phones; computer software to enable the transmission of mapping, navigation, traffic, weather and point-of-interest information to telecommunications networks; wireless handheld devices, namely, electronic handheld units in the nature of mobile, slate, and tablet computers, and navigation devices; computer software to be used for viewing and downloading electronic maps; computer software for operating route planners</p> <p><b><u>Class 38:</u></b> Telecommunication carrier services, namely, providing access to third-party electronic databases by means of one-way or two-way wireless connectivity, including corporate and home/personal data, and providing access to GPS (Global Positioning System) navigation services</p> <p><b><u>Class 39:</u></b> Providing GPS (Global Positioning System) navigation services; providing navigation, traffic and point-of-interest-navigation information via telecommunication networks, mobile phones, telephones, smartphones, electronic handheld units and navigation devices</p> <p><b><u>Class 42:</u></b> providing mapping and point-of-interest-mapping information via telecommunication networks, mobile phones, telephones, smartphones, electronic handheld units and navigation devices; software as a service (SAAS) services, namely, hosting third-party software and applications for personal digital assistants (PDAs), wireless phones, mobile phones, cellular phones, smart phones, mobile computers and tablet</p>



TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			computers, all for use by others; providing search engines for obtaining data via communications networks
BLACKBERRY WEBWORKS	4403721	September 17, 2013	<b><u>Class 9:</u></b> Computer software development tools for developing software for web-based applications.
BLACKBERRY WORLD	4532194	May 20, 2014	<p><b><u>Class 9:</u></b> Computer software for accessing, displaying, browsing, transmitting and downloading software, mobile application software, computer game software, music, and multimedia, audio, and video files; downloadable computer software for accessing, displaying, browsing, transmitting and downloading software, mobile application software, computer game software, music, and multimedia, audio, and video files.</p> <p><b><u>Class 35:</u></b> Retail store services featuring computer software, downloadable software, mobile application software, downloadable computer game software, downloadable music, and downloadable multimedia, audio, and video files; and online retail store services featuring computer software, downloadable software, mobile application software, downloadable computer game software, downloadable music, and downloadable multimedia, audio, and video files.</p>
BLACKBERRY CLASSIC	4732984	May 5, 2015	<b><u>Class 9:</u></b> Mobile phones; smartphones.
BLACKBERRY BOLD	4676913	January 27, 2015	<b><u>Class 9:</u></b> Apparatus for recording, transmission or reproduction of data, sound or images, namely, electronic handheld units, mobile phones, telephones, smartphones, personal digital assistants (PDAs) for the wireless transmission of data and/or voice signals; electronic handheld units, mobile phones, telephones, smartphones, personal digital assistants (PDAs), with capabilities of e-mail, pager, fax, radio, personal organizer, cellular connectivity, wireless Internet connectivity, mp3 player, satellite navigational system, GPS (Global Positioning System) receiver, global positioning system data logger for recording and classification of trips, digital camera,

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			<p>digital video camera and/or computer operating system; electronic handheld units for recording, organizing, transmitting, playing and reviewing text, data, video and audio files, and accessories for electronic handheld units, telephones, mobile phones, smartphones, and personal digital assistants (PDAs) for the wireless transmission of data and/or voice signals, namely, batteries, battery chargers, speakers, headsets, microphones, belt clips, specialty holsters, carrying cases, battery covers, battery doors, charging pods, docking/charging cradles, holders, desktop stands, data cables, electric adapter cables and electrical wires; car kits for the adaptation of portable communication apparatus and instruments for use in vehicles, comprising antennas, antenna transmission wires, antenna adapters, cables, car phones, hands-free microphones, phone holders, speakers, car chargers for mobile telephone batteries, hands-free holders. computer software, namely, software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server, software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one way and/or two-way wireless connectivity to data, namely, corporate data; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data stored on or associated with a computer</p> <p><b><u>Class 38:</u></b> Telecommunication services, namely, the synchronization, transmission and sharing of voice, sound, image and/or data signals through a wireless data network; providing access to the Internet; providing access to electronic databases; providing access to global positioning system (GPS) navigation services; providing e-mail services; wireless data messaging services, particularly</p>

TRADEMARK	REG. NO.	REG. DATE	GOODS/SERVICES
			<p>services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services via the internet and other computer and electronic communication networks and wireless devices; telecommunications consultation, namely, providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, namely, corporate and home/personal data, and/or voice communications</p> <p><b><u>Class 42:</u></b> Consultancy and technical support services, namely, diagnosing computer hardware and software problems for telecommunication and Global Positioning System (GPS) services; technical support services, namely, updating and maintenance of computer software and troubleshooting support programs for diagnosis and resolution of wireless connectivity devices and related computer software and hardware problems</p>

## **CERTIFICATE OF SERVICE**

I hereby certify that on this 26th day of October, 2016, a true and complete copy of the foregoing **Notice of Opposition** has been served upon Applicant by delivering the same first class mail to the following address:

Robert J. Kennedy, Esq.  
Birch Stewart Kolasch & Birch, LLP  
PO Box 747  
Falls Church, VA 22040-0747

/L. Danielle Toaltoan/

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